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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,880	08/04/2003	Philip G. Wessells	20003-7012	5236

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,880

Applicant(s)

WESSELLS ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-18 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16, 23, 24 and 37 is/are allowed.
- 6) ☒ Claim(s) 1-6, 11, 12, 17, 25-28 and 33-36 is/are rejected.
- 7) ☒ Claim(s) 7-10, 18 and 29-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 11, 12, 17, 25-28, and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Maxwell (U.S. Pat. No. 2,629,344; previously of record).

Maxwell discloses a material forming apparatus. In the embodiment depicted in Figure 3, the apparatus comprises a shaft (22) having a gripping end and a shaping end remote from the gripping end. A shaper (70) is disposed at the distal end, with the shaper including a pair of opposing forming elements (72 and 74) attached to the distal end for relative pivotal motion between them, with the forming elements each including a cavity for shaping a particular material (see Fig. 3). In moving between the open positions and closed positions shown in Fig. 3, the forming elements go through a relative pivotal motion between them of about 180 degrees (about 90 degrees for each section 72 and 74). As evidenced by Figs. 1 and 3, the forming elements can define a opening at a plurality of positions, including positions short of that shown in Fig. 3 wherein the

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opening would lie in a plane generally disposed parallel to the longitudinal axis of the shaft.

Claims of the instant application recite an intended use for the apparatus. Specifically, the apparatus is to be used for collecting and compressing a compressible medium, with the compressible medium more specifically being defined as snow. Also, the claims recite that the apparatus is used by a single-handed operation. It is well settled the intended use of an apparatus is not germane to the issue of the patentability of apparatus claims. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In the instant case Maxwell discloses all of the structural features of the claimed apparatus, and is therefore clearly capable of being used with a compressible material such as snow. Maxwell also could be operated in a single-handed manner. Maxwell therefore anticipates the claimed use limitation of the claims.

3. Applicant's arguments filed 30 December 2005 have been fully considered but they are not persuasive.

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With respect to the Maxwell reference, Applicant asserts that Maxwell disclosed both of the scooper and former to be pivotally coupled to the shaft, and thereby fails to show one of the elements as "fixed" as is recited in the claims of the instant application. Applicant's argument centers around the term "fixed" meaning that the elements are not moveable relative to the shaft, as Applicant asserts was described in the originally filed application.

The originally filed application did not use the term "fixed." Note for example, the original claims described the related elements as "coupled" to the shaft. Nor is seen in the disclosure where either of the elements are described as immovable relative to the shaft (Applicant asserts that this is disclosed, but does not point to a specific reference in the originally filed application). While the term "fixed" could reasonably be understood to be synonymous with the previously used term "coupled," and thereby mean that the element and shaft cannot be separated, to construe the term as more restrictive as meaning "immovable relative to one another" appears not to be enabled by the originally filed application. Thus, such an interpretation would present a problem of new matter.

Maxwell does disclose both elements to be fixed (as construed to mean merely coupled) to one another. Maxwell

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therefore anticipates a reasonable interpretation of the claims, whereby the claims are not construed to introduce new matter.

4. Claims 14-16, 23, 24, and 37 are allowed. See the reasons for indicating allowable subject matter in the previous Office Action. Claims 7-10, 18, and 29-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions

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on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at (866) 217-9197 (toll-free).

 3-20-6
Donald Heckenberg
Primary Examiner
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